

**REMARKS**

Claims 1-4, 6-10, 12, 13, and 15-18 are pending in the instant application with claim 1 in independent form. No claims are currently amended. Dependent claims 5, 11, and 14 were previously cancelled. No claims are presently added or cancelled.

The Abstract of the instant application is currently amended to correct typographical errors in accordance with suggestions by the Examiner. The Applicants respectfully submit that no new subject matter is added through the amendments to the Abstract.

In the final Office Action, the Abstract stands objected to in view of various typographical errors. Claims 1-4, 7-10, 12, 13, and 16-18 stand rejected under 35 USC §103(a) as being unpatentable over Morita et al. (PCT Pub. No. WO03/072656) in view of Kuwabara et al. (US Pre-Grant Pub. No. 2003/0010962). Claim 5 stands provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over co-pending U.S. App. Serial No. 11/912,631. Dependent claims 6 and 15 are objected to as depending from a rejected base claim, but would otherwise be allowable if rewritten in independent form.

The Applicants respectfully submit that, in view of the amendments to the Abstract, the bases for the Examiner's objection thereto are overcome and, to the extent that the objections are not overcome, the Applicants respectfully clarify the language of the Abstract. The Applicants also respectfully traverse the rejection of independent claim 1 under 35 U.S.C. §103(a) over Morita et al. in view of Kuwabara et al., with the accompanying Declaration executed by inventor Hiroshi Ueki supporting the Applicants' position.

**As to the Objections to the Abstract**

The Applicants respectfully submit that after the instant amendment to the Abstract, the only remaining issue is the Examiner's objection that " $0 \leq a \leq 0.8$ ; and, on average" should be changed to " $-0 \leq a \leq 0.8$ ; and "c" on average--". The Applicants respectfully submit that the Examiner's objections in this regard are in error, and that the wording " $0 \leq a \leq 0.8$ ; and, on average" is correct with the phrase "on average" referring the value of the variable "b". The Applicants' current wording is clearly correct when it is considered how the phrase "on average" is used throughout the rest of the Abstract.

In view of the foregoing, the Applicants respectfully submit that the Examiner's objections to the Abstract are overcome and must be withdrawn.

**As to the Rejections of Claims 1-4, 7-10, 12, 13, and 16-18 Under 35 U.S.C. §103(a) Over Morita et al. and Kuwabara et al.**

The Applicants respectfully maintain the previous traversal of these rejections as set forth in the Amendment filed on April 1, 2009, with the previous arguments supplemented by the following arguments in response to the Examiner's comments and with the previous arguments further supplemented by the accompanying Declaration that has been executed by inventor Hiroshi Ueki. In particular, the Applicants maintain that one of skill in the art, with knowledge of the teachings of Morita et al., would not reasonably have been expected to arrive at the invention as now claimed in amended independent claim 1 based upon the additional teachings contained in Kuwabara et al.

To establish the rejections over Morita et al. and Kuwabara et al, the Examiner has relied upon Morita et al. to teach the organopolysiloxane (A) that is represented by formula (1)

in independent claim 1 and to further teach the curing accelerator (C). The Examiner has also noted the teaching in Morita et al. of a silicone resin (B), which can be a phenolic resin as set forth in paragraph [0031] of Morita et al. Recognizing that Morita et al. fails to explicitly teach the phenolic linear-chain organopolysiloxanes (B) of independent claim 1, the Examiner has turned to the teachings of Kuwabara et al. to teach organopolysiloxanes that satisfy the requirements of the phenolic linear-chain organopolysiloxanes (B) of independent claim 1.

The Applicants respectfully maintain that it would **not** be obvious to a person of ordinary skill in the art to modify the compositions of Morita et al. by adding the phenolic polysiloxanes taught by Kuwabara et al. to find a teaching in the prior art of curable silicone composition as claimed in the instant independent claim 1 as amended. The Applicants previously provided a synopsis of the relevant standards for establishing obviousness in the wake of *KSR v. Teleflex*. While the Applicants refrain from repeating the synopsis, the Applicants respectfully reiterate “the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art **would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge**” (emphasis added, see MPEP 2141(II)).

The Applicants respectfully maintain that the Examiner’s conclusions do not reflect what one of skill in the art would have reasonably expected to have been able to do in view of the knowledge gained from the combined teachings of Morita et al. and Kuwabara et al. such that one of skill in the art would not have modified Morita et al. based on the teachings of Kuwabara et al. in the manner necessary to arrive at the invention claimed in independent claim

1 as amended. The basis of the Applicants' position are the same as previously argued: 1.) Morita et al. and Kuwabara et al. are concerned with substantially different applications of the compositions taught therein, 2.) the phenolic resins of Morita et al. are of a different basic structure than the phenolic resins of Kuwabara et al. that the Examiner has equated, and 3.) the respective roles of the phenolic resins in Morita et al. and Kuwabara et al. are different. Instead of repeating the previous arguments, the Applicants respond to the Examiner's individual responses to the previous arguments below, with the Applicants' further arguments intended to supplement and not to replace the previous arguments. The Applicants respectfully submit that the sum of the three considerations summarized by 1.)-3.) prove that one of skill in the art would not have reasonably expected to have been able to practice the invention claimed in the instant independent claim 1 based upon the combined teachings of Morita et al. and Kuwabara et al.

**1.) Morita et al. and Kuwabara et al. are concerned with substantially different applications**

The Examiner has responded to the Applicants previous arguments in this regard by attempting to characterize the Applicants' arguments as arguments based upon different fields of endeavor. This is not necessarily the Applicants' argument. Arguments based upon different fields of endeavor are generally associated with arguments based upon a position of non-analogous art. To be clear, the Applicants are not arguing a position that Kuwabara et al. is non-analogous art to the instant invention; rather, the Applicants' arguments are based upon a logical interpretation of the teachings of Morita et al. and Kuwabara et al. with regard to the ultimate question of what would a person of ordinary skill in the pertinent art have known at the time

of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. The different intended applications of the compositions of Morita et al. and Kuwabara et al., as previously described, clearly provide insights that help to resolve the issue of what a person of ordinary skill in the art would have reasonably expected to have been able to do in view of the knowledge from the combined teachings of Morita et al. and Kuwabara et al. The Applicants respectfully urge the Examiner to reconsider these differences in intended applications without characterizing the teachings of Morita et al. and Kuwabara et al. based upon rigid analysis. After all, the overriding principle to emanate from the Court's holding in *KSR v. Teleflex* is that it is improper to apply rigid tests for purposes of settling obviousness issues.

In view of the above, the Applicants respectfully submit that the different intended applications for the compositions disclosed in Morita et al. and Kuwabara et al. would weigh heavily on a person of ordinary skill in the art when determining whether to substitute and/or supplement the respective compositions with components from the other of the compositions. Again, whereas Morita et al. is indicated as preparing electrical or electronic element sealing resin compositions, paint, coating agents, and adhesives due to flowability properties prior to curing and flame retarding properties after curing (see paragraph [0047] of Morita et al.), Kuwabara et al. is primarily concerned with a composition that can be used for bonding optical elements in optical isolators and other optical devices. Bonding and impact strength properties of the composition of Kuwabara et al. are of utmost importance, including the ability of the composition to form bonds that remain intact under hot humid conditions or thermal cycling

conditions (see paragraph [0007] on page 1 of Kuwabara et al.), whereas flame retardance is the focus of the compositions of Morita et al. (due to the intended electrical applications for the compositions of Morita et al.). The Examiner can nary dispute that such disparate important properties of the respective compositions of Morita et al. and Kuwabara et al. would be considered by a person of skill in the art when making determinations as to whether to include components from one composition in the other of the compositions. This is especially true when it is considered that there are no teachings in the respective references as to whether a given component could perform adequately for purposes of the important properties of the other of the respective references.

In further support of the above, flame retardant properties are mentioned as an important property in paragraph [0031] on page 13 of Morita et al., wherein certain phenolic resins are described as preferred due to superior flame retardant properties of the cured products obtained with the composition including the phenolic resins. As such, the phenolic resins of Morita et al. play a significant role in providing the desired flame retardant properties of the cured products obtained, and one of skill in the art attempting to supplement the teachings of Morita et al. would clearly consider flame retardant properties of alternative phenolic resins when determining the suitability thereof for use in the composition of Morita et al. Absent any guidance in Kuwabara et al. as to flame retardant properties of the phenolic resins taught therein, and given the different purposes altogether for using the phenolic resins as described in Kuwabara et al., the Applicants respectfully submit that there is no basis for finding that a person of skill in the art would reasonably have been expected to supplement the composition of

Morita et al. with the phenolic resins taught by Kuwabara et al. Again, there must be some basis in the art for concluding that one of skill in the art would have reasonably expected to have been able to supplement and/or replace the phenolic resins of Morita et al. with the phenolic resins of Kuwabara et al. The Applicants respectfully submit that the different intended uses for the resins of Morita et al. and Kuwabara et al. strongly weigh in favor of the Applicants' position that it would be **unreasonable** to expect one of skill in the art to supplement and/or replace the phenolic resins of Morita et al. with the phenolic resins of Kuwabara et al. based upon the fact that there is no guidance within the art to suggest such supplementation or replacement to one of skill in the art while still providing a reasonable expectation that the desired properties of the composition of Morita et al. can be achieved.

**2.) The Phenolic Resins of Morita et al. are of a Different Basic Structure than the Phenolic Resins of Kuwabara et al.**

The Applicants also maintain that the basic structure of the phenolic resins taught in the respective references are different such that one of skill in the art would not have known to substitute one for the other, especially in view of the importance Morita et al. places upon flame retardance attributable to the phenolic resins taught therein. In response to the Applicants' previous arguments, the Examiner has disputed the Applicants' position that Morita et al. excludes phenolic resins having siloxanes in the main chains thereof. In this regard, the Applicants submit the Declaration executed by inventor Hiroshi Ueki. Mr. Ueki is also a named inventor on Morita et al., and is in a position to properly attest to the structure of the phenolic resins in Morita et al. as a person of ordinary skill in the art would interpret them. The

Applicants respectfully submit that Mr. Ueki's statements are in agreement with the position previously advanced by the Applicants, which is that a person of ordinary skill in the art would interpret Morita et al. to exclude phenolic resins that include siloxanes in the main chain of the resin.

Again, in view of the differences between the phenolic resins taught by Morita et al. (as attested to in the Declaration executed by Mr. Ueki) and the phenolic resins taught by Kuwabara et al., coupled with the fact that the phenolic resins of Kuwabara et al. **are not even included in any of the broad groups of suitable phenolic resins taught by Morita et al.**, the Applicants respectfully submit that one of skill in the art clearly would not have chosen to include the phenolic resins of Kuwabara et al. in the composition of Morita et al. This is especially the case because Morita et al. provides descriptions of various phenolic resins that encompass countless different phenolic resins, any of which would be suitable for the invention thereof, and there is nothing with Kuwabara et al. to suggest that the specific phenolic resins taught therein would even be a suitable alternative to the phenolic resins of Morita et al.

**3. The Respective Roles of the Phenolic Resins of Morita et al. and Kuwabara et al. are Different**

As alluded to above in the preceding paragraphs, the Applicants respectfully submit that the roles of the respective phenolic resins of Morita et al. and Kuwabara et al. are different such that one of skill in the art would not have been taught to include the phenolic resins of Kuwabara et al. in the compositions of Morita et al. merely based upon the fact that Morita et al. teaches the inclusion of a phenolic resin in the composition taught therein. As set forth above,



Morita et al. teaches inclusion of phenolic resins therein with certain phenolic resins being desirable due to flame retardant properties thereof. However, Morita et al. generally discloses the compositions taught therein to have low melt viscosity and excellent reactivity and dispersibility in organic resins to thereby form a cured resin of excellent moldability and superior flame retardant properties (see paragraph [0005] on page 2 of Morita et al.). Notably, no teachings exist in Kuwabara et al. that would suggest to a person of ordinary skill in the art that the phenolic resins described therein provide the flame retardance properties that are the primary focus of Morita et al.

The Applicants recognize that there are similarities between the phenolic resins taught by Morita et al. and Kuwabara et al. in that there is a common recognition that reduction in stress in cured products is one result of the presence of the siloxane groups in the respective resins. However, the Applicants respectfully submit that one of skill in the art would not merely focus upon that one common feature when determining whether to substitute the phenolic resin of Morita et al. with the phenolic resins of Kuwabara et al. To draw an analogy, the Examiner's position is akin to a position that, during baking of a cake, a baker would substitute sugar for salt based upon the mere fact that both are soluble in water. Clearly, the baker would not make such a substitution without also considering other factors such as sweetness of the proposed alternative (salt, in this example). Likewise, even though there are similarities between the phenolic resins taught by Morita et al. and Kuwabara et al. relative to stress reduction properties, such properties would clearly not be the only properties considered by a person of skill in the art when determining whether to make the substitution asserted by the Examiner, especially when

the other properties of the respective compositions of Morita et al. (e.g., flame retardance) and Kuwabara et al. (bonding and impact strength properties, ability of the composition to form bonds that remain intact under hot humid conditions or thermal cycling conditions) are of utmost importance.

**4. The Logical Conclusion Drawn by Weighing 1.)-3.) Above is that a Person of Skill in the Art, With Knowledge of Morita et al., Would Not Reasonably Have Been Expected to Practice the Invention Claimed in Independent Claim 1 of the Instant Claims Based Upon the Teachings of Kuwabara et al.**

The Applicants respectfully reassert that the ultimate question is whether a person of skill in the art, with knowledge of the teachings of Morita et al, would reasonably be expected to arrive at the instant invention based upon other teachings in the art (in this case, the teachings of Kuwabara et al.). The Applicants respectfully submit that the only conclusion that can be reached, in view of the above arguments set forth in 1.)-3.) above, is that a person of skill in the art, with knowledge of Morita et al., would not reasonably have been expected to arrive at the instant invention based upon the teachings of Kuwabara et al.

In view of the foregoing, the Applicants respectfully submit that the rejections of dependent claim 5 under 35 USC §103(a) over Morita et al. in view of Kuwabara et al., as they now apply to independent claim 1, are overcome and must be withdrawn.

**Rejection of Claim 8 under Obviousness-type Double Patenting Over the '631 Application**

The Applicants continue to request that this rejection be held in abeyance until there is an indication of allowable subject matter in the instant application.

The Applicants respectfully submit that the instant claims are in condition for allowance and respectfully request such allowance. This Amendment is filed timely with the appropriate fee for a Request for Continued Examination (RCE). As such, it is believed that no further fees are presently due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2789 in the name of Howard & Howard.

**Respectfully submitted,**

**HOWARD & HOWARD ATTORNEYS, PLLC**

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Date

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